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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,949	03/07/2002	Rainer Tilse	4597-039	2820

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EXAMINER

WILSON, JOHN J

ART UNIT	PAPER NUMBER
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3732

DATE MAILED: 06/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

2

Office Action Summary	Application No. 10/069,949	Applicant(s) TILSE, RAINER	
	Examiner John J. Wilson	Art Unit 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14-17, 20 and 21 is/are allowed.
- 6) ☒ Claim(s) 3-13, 18, 19, 22 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 3-13 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claim 3, a connecting member providing a “solid connection” between the sound generator and the nozzle is improper new matter. The disclosure teaches a cartridge 9 having a nozzle 12 and a coupling 14 with the oscillator and shows 14 touching cartridge 9 in Fig. 14, however, there is no further description of the coupling. Because 9 is removable, it appears that the shown coupling can only be a contact between 14 and 9 that allows for 9 to be removed, and as such, there is no support for a solid connection as now claimed. Also in claim 3, “once the filing compound has left the nozzle, the action of the sound on the compound diminishes rapidly” is new matter not originally disclosed. In claim 9, the new limitations of “simultaneously” switched on and off is improper new matter. The disclosure teaches an electric switch that switches the oscillator on when lever 4 is actuated and off when lever 4 is returned to its original position, however, there is not showing of the switch nor teaching of exactly how the lever actuates and turns off the switch. Therefore, there is no teaching of the switch being activated simultaneously when the lever is first pushed.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5, 18, 19, 22 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to enable one of ordinary skill in the art to make and use the claimed subject matter which applicant regards as the invention. The disclosure does not adequately teach how to make and use a sound generator that is coupled to the holder. Applicant cites the last paragraph of page 6 of the specification for support of this language, however, the holder, as defined in the disclosure is the holding portion 2 which has a recess 8 in which a cartridge can be inserted. It is noted here that it is assumed that the limitation of "nozzle" is not referring to the shown nozzle 12, however, instead is referring to both the nozzle 12 and cartridge 9. The only teaching of coupling the sound oscillator is teaching coupling it to the cartridge 9 by element 14. There is no teaching of how to couple the oscillator to the holder 2 as being claimed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 4, 11, 13 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (3792530). Smith shows a hand held device 1, nozzle 5, means for conveying 6, 7, handle

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as shown and a generator 8, which can be a sound generator, column 8, lines 5-7. The generator 8 is connected to the nozzle through the hand piece and through plunger 6 which inherently contacts the inner walls of nozzle 5, and as such, will inherently convey vibration to the nozzle, and the nozzle is inherently capable of functioning to transmit the vibrations to a filling compound flowing through the nozzle when used in that manner. The action of the sound on the inferentially claimed compound once the compound has left the nozzle is an obvious matter of choice in the intended use of the claimed structure with an inferentially claimed compound. Smith also teaches that the generator can oscillate while filling, see column 6, lines 30-44.

Claims 9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirdes (4768955). Hirdes shows a supply container 5, nozzle 10, 11, means for conveying 3, handle 2, ultra sound generator 50, column 4, lines 60-67 and actuating button 6. The oscillator 50 will inherently set the nozzle into oscillation. All of the claimed structure being shown, to use with for filling a synthetic resin is an obvious matter of intended use of a known structure to one of ordinary skill in the art.

Claims 5, 8 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (3792530) in view of Nielsen (3890713). Smith shows the structure as described above, however, does not show an exchangeable supply container. Nielsen shows an exchangeable supply container and nozzle, see Figs. 7-9. It would be obvious to one of ordinary skill in the art to modify Smith to include an exchangeable container as shown by Nielsen in order to more conveniently refill the handpiece. As to claim 8, Smith does not show the use of a pneumatically excited oscillator. Nielsen shows creating vibrations with a pneumatic oscillator, column 2, lines

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62-64. It would be obvious to one of ordinary skill in the art to modify Smith to include the use of a pneumatic oscillator as shown by Nielsen in order to make use of art known equivalent ways of producing vibrations. It is also noted that there is no disclosed criticality to the type of oscillator used.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (3792530) in view of Werly (5007837). Smith shows the structure as described above, however, does not show the use of a piezoelectric oscillator. Werly shows creating vibrations with a piezoelectric oscillator 41. It would be obvious to one of ordinary skill in the art to modify Smith to include the use of a piezoelectric oscillator as shown by Werly in order to make use of art known equivalent ways of producing vibrations. It is also noted that there is no disclosed criticality to the type of oscillator used.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (3792530) in view of Balamuth et al (3809977). Smith shows the structure as described above, however, does not show the use of a magnetostrictive oscillator. Balamuth shows creating vibrations with a magnetostrictive oscillator, column 7, lines 28-34. It would be obvious to one of ordinary skill in the art to modify Smith to include the use of a magnetostrictive oscillator as shown by Balamuth in order to make use of art known equivalent ways of producing vibrations. It is also noted that there is no disclosed criticality to the type of oscillator used.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (3792530) in view of Fishburne, Jr. (5839895). Smith shows the structure as described above, however, does not show the use of a spray gun. Fishburne teaches that the structure produces a spray, column 5, lines 1-5. It would be obvious to one of ordinary skill in the art to modify Smith to include producing a spray as shown by Fishburne in order to make use of known properties of art known delivery devices. It is further noted that the present disclosure does not specify any specific type of spray gun, therefore, to call the above combination a spray gun is an obvious matter of choice to the skilled artisan.

Allowable Subject Matter

Claims 14-17, 20 and 21 are allowed.

Claims 18 and 19 stand rejected under 35 U.S.C. 112, second paragraph, only.

Response to Arguments

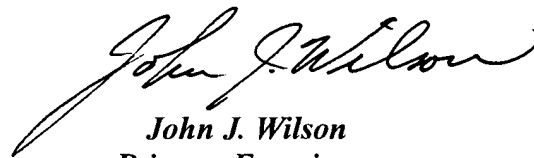
Applicant's arguments filed May 4, 2004 have been fully considered but they are not persuasive. The removable connection as taught by the present disclosure of element 14 against element 9 is held to be broad enough to be met by the connection of member 6 of Smith within the nozzle 5. The term simultaneously is not specifically defined in the present disclosure, and therefore, an interpretation of using one switch to activate both as shown by Hirdes properly meets the claim language.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Wilson whose telephone number is 571-272-4722). The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P. Shaver, can be reached at 571-272-4720). The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


John J. Wilson
Primary Examiner
Art Unit 3732

jjw
June 3, 2005